



23 APR 2003

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Joseph S. Tripoli
THOMSON MULTIMEDIA LICENSING INC.
Patent Dept.
P.O. Box 5312
Princeton, NJ 08540

In re Application of :
BASSET, Jean-Claude :
U.S. Application No.: 09/980,355 :
PCT No.: PCT/FR00/01463 :
Int. Filing Date: 29 May 2000 :
Priority Date: 02 June 1999 :
Attorney's Docket No.: SCP061792 :
For: DIGITAL-TELEVISION :
RECEIVER/DECODER DEVICE WITH :
PLAYBACK . . . :

DECISION

The decision is in response to applicant's "Renewed Petition Under 37 CFR 1.47 for Acceptance of Application Without Participation of Inventor" filed 24 March 2003.

BACKGROUND

On 20 September 2002, a decision dismissing applicant's petition under 37 CFR 1.47(b) was mailed. Applicant met all of the requirements except item (5) of 37 CFR 1.47(b) and was given two months to respond with extensions available.

On 24 March 2003, applicant submitted the instant renewed petition which was accompanied by, *inter alia*, a four-month extension of time and fee; a copy of the French priority document and accompanying English translation; a declaration by a licensed French Patent Attorney; and copies of the applicable French laws in English.

DISCUSSION

Previously, the 37 CFR 1.47(b) applicant failed to satisfy item (5) of 37 CFR 1.47(b) which requires proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the above-captioned application. Specifically, the 37 CFR 1.47(b) applicant did not (1) provide any evidence disclosing how Dassault Automatismes et Telecommunications S.A. ("D.A.T.") originally obtained the rights of the patent from the sole inventor, Mr. Basset; (2) show that they have acquired rights in the PCT application; and (3) show that the disclosure of the priority document is the same as the present application. In addition, a statement under 37 CFR 3.73(b) pursuant to MPEP § 324 would also be required if the 37 CFR 1.47(b) applicant relied upon an assignment

to demonstrate sufficient proprietary interest.

MPEP § 409.03(f) discusses three ways to show the requisite proprietary interest sufficient under 37 CFR 1.47(b). These are to: (1) show that the invention has been assigned to the 37 CFR 1.47(b) applicant; (2) show that the inventor has agreed in writing to assign the invention to the 37 CFR 1.47(b) applicant; or (3) show that the 37 CFR 1.47(b) applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the invention has not been assigned, or if there is no written agreement to assign, MPEP § 409.03(f) elaborates on how a 37 CFR 1.47(b) applicant may demonstrate that he or she otherwise has a sufficient proprietary interest in the matter, and states:

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

In the renewed petition, the 37 CFR 1.47(b) applicant has provided a certified copy of the priority document with an accompanying English translation and declares that this is "evidencing that the priority document is the same as the present application." A review of the English translation of the priority document and the above-identified application confirm this claim.

Moreover, the 37 CFR 1.47(b) applicant states that "Exhibit E, clause 2.1, paragraph 9" previously submitted with the initial petition provides the 37 CFR 1.47(b) applicant with "proprietary interest in the PCT application and the present application." A review of this clause shows that "Patent Applications" are defined broadly to include "future patent applications filed abroad." This is sufficient to show that the rights in the international application followed the original patent.

Finally, the 37 CFR 1.47(b) applicant has provided a legal memorandum by a French Patent Attorney, Brigitte Ruellan who states that "I conclude that under French

Law, specifically Article L611-7, and the applicable legal cases, and in view of his employment as an Engineer with D.A.T., which resulted in the filing of the priority document, D.A.T. properly acquired rights to the priority document from Mr. Basset." An English translation of Article L611-7 was submitted with the renewed petition as required. The 37 CFR 1.47(b) applicant also included a statement with an accompanying English translation from the Human Resources manager of Thales e-Transaction, S.A. attesting that Mr. Basset was employed by the company (which was formerly D.A.T.) from 19 September 1973 to 07 May 2000.

The evidence provided is sufficient to satisfy the requirements of item (5) of 37 CFR 1.47(b).

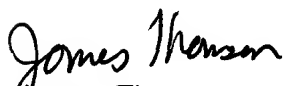
CONCLUSION

Applicant's renewed petition under 37 CFR 1.47(b) is **GRANTED**.

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the non-signing inventor at the last known address of record as set forth in the papers filed 25 July 2002, and a notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

Applicant has completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 29 May 2000, under 35 U.S.C. 363, and a 35 U.S.C. 371(c) date of **25 July 2002**.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.


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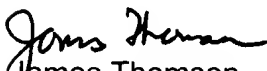
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PROGRAMMING :

Dear Mr. Basset:

You are named as the sole inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(b) and 35 U.S.C. § 118. Should a patent be granted, you will be designated as the inventor.

As the inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.


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